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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,335	04/10/2006	Martin Krohn	112701-707	7681

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EXAMINER	
GWARTNEY, ELIZABETH A	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary	Application No.	Applicant(s)	
	10/595,335	KROHN ET AL.	
	Examiner	Art Unit	
	Elizabeth Gwartney	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20061115*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 2-9, 11-14, and 16-20 are objected to because of the following informalities:

Given that claims 2-9 and 16-19 and claims 11-14 and 20 depend from claims 1 and 10, respectively, in order to have proper antecedent basis, it is advised that in claims 2-9 and 16-19 a fat based confectionary product is changed to "The fat-based confectionary" and that for claims 11-14 and 20 "A food product" is changed to "The food product."

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-4, 9-17 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3-4 and 17, it is not clear if the plasticizer or ingredient is part of the film coating or the confectionary product.

Regarding claim 9, the recitation of "a method for producing a food product" renders the scope of the claim indefinite because the only method step recited is "using" a fat-based confectionery product. It is not clear what the “use” of the confectionery product is or what steps must be taken when “using” the confectionery product.

Regarding claim 10, the recitation “comprising a fat-based confectionery product, a heat shape stable and heat resistant fat-based confectionery product comprising a film" renders the

claim indefinite. It is unclear if the food product comprises both a fat-based confectionery product ***and*** a heat shape stable and heat resistant fat-based confectionery product comprising a film ***or*** if the food product comprises a fat-based confectionery product that is heat shape stable and heat resistant and comprises a film. To further prosecution the examiner interprets the claim to read " A food product comprising a heat shape stable and heat resistant fat-based confectionery product comprising a film coating."

Regarding claim 15, the recitation of "a method for providing a food" renders the scope of the claim indefinite because the only method step recited is "using" a fat-based confectionery product to form a product wherein the coloring does not bleed from the coating into or onto the food product. It is not clear what steps must be taken when "using" the confectionery product to make the food product wherein the coloring does not bleed from the coating.

Claim 15 recites the limitation "the coloring" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the film forming agent" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 19, the recitation "2 to 5% by weight" renders the claim indefinite because it is unclear what percentage of weight the film coating is being measure against. Is it "by weight of the fat-based confectionery?"

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Woznicki et al.(US 4,802,924).

Regarding claims 1-4, Woznicki et al. disclose a film coated chocolate product wherein the film coating comprises a cellulosic polymer, polydextrose, a plasticizer, and lecithin (C2/L32-68).

Given that Woznicki et al. disclose a film coated chocolate product identical to that presently claimed, it is clear that it would inherently be heat shape stable and heat resistant.

Regarding claim 16, Woznicki et al. disclose all of the claim limitations as set forth above and that the film forming coating agent is polydextrose and a cellulosic polymer selected from the group consisting of hydroxypropyl methylcellulose or hydroxypropyl cellulose (C2/L32-40).

Regarding claim 17, Woznicki et al. disclose all of the claim limitations as set forth above and that the plasticizer is chosen from the group consisting of polyethylene glycol and propylene glycol (C2/L41-42).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 6-8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woznicki et al. (US 4,802,924).

Regarding claims 6-7 and 18-19, Woznicki et al. disclose all of the claim limitations as set forth above. Woznicki et al. does not explicitly disclose that the film coating is 0.01% to 10%, 0.5 to 6%, or 2 to 5% by weight of the fat-based confectionery product or that the thickness of the film coating is 1 micrometer to 1 millimeter. As coating smoothness and shininess are variables that can be modified, among others, by adjusting the amount of film coating and the film thickness, the precise amount of film coating on the fat-based confectionery product and film thickness would have been considered a result effective variable by one of ordinary skill in

the art at the time of the invention. As such, without showing unexpected results, the claimed amount of film coating and film thickness cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the amount of film coating and film thickness on the chocolate product of Woznicki et al. to obtain the desired shininess and smoothness of the coating (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Regarding claim 8, Woznicki et al. disclose all of the claim limitations as set forth above and that the product is a chocolate product coated with a film comprising lecithin (C2/L49,64-68).

Woznicki et al. does not explicitly disclose that the chocolate product is less than 15 millimeters in width. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thickness of the chocolate product since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woznicki et al. (US 4,802,924) in view of Steffenino et al. (US 6,274,162).

Regarding claim 5, Woznicki et al. disclose all of the claim limitations as set forth above and that the film coating comprises colorant (C2/L43-48). However, Woznicki et al. does not disclose that the film coating comprises flavorant.

Steffenino et al. teach a film coated confectionery product wherein the film coating comprises hydroxyethyl cellulose, a plasticizer, a colorant and a flavorant (Abstract). Steffenino et al. teach that flavorant is used primarily for taste and/or odor masking (C3/L38-39).

Woznicki et al. and Steffenino et al. are combinable because they are concerned with the same field of endeavor, namely, film-coated confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have added flavorant, as taught by Steffenino et al., to the film coating of Woznicki et al. for the purpose of adding flavor and masking off-flavors.

11. Claims 9-10, 13, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooking Light ("Chewy Chocolate-Chip Cookies") in view of Woznicki et al. (US 4,802,924).

Regarding claims 9-10, 13, 15 and 20, Cooking Light discloses chocolate chip cookies comprising chocolate chips (i.e. fat-based confectionery product) and flour (p.1/Title, Ingredients). Cooking Light also discloses a method to produce the cookies by using chocolate chips (p.1/entire recipe). Cooking Light does not disclose that the confectionery product is heat shape stable, heat resistant or comprises a film coating.

Woznicki et al. teach a chocolate film coated with polydextrose, cellulosic polymer, plasticizer, lecithin, and colorant (Abstract, C2/L33-68). Given that Woznicki et al. teach a film

coated chocolate identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

Cooking Light and Woznicki et al. are combinable because they are concerned with the same field of endeavor, namely, confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the film-coated chocolate, as taught by Woznicki et al. in the chocolate chip cookies of Cooking Light because doing so would amount to nothing more than the use of a known chocolate confectionery for it use in a known environment to accomplish entirely expected results. Further, by doing so the shape of the chocolate would remain intact and more colorful cookies would be produced.

Given that Woznicki et al. disclose a film coated chocolate identical to that presently claimed, it is clear that intrinsically the color from the coating would not bleed into or onto the food product.

12. Claims 10-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bon Appétit ("Black Forest Fudge") in view of Woznicki et al. (US 4,802,924).

Regarding claims 10-11, Bon Appétit discloses fudge comprising chocolate chips sprinkled on top (i.e. fat-based confectionery product). Bon Appétit does not disclose that the confectionery product is heat shape stable, heat resistant or comprises a film coating.

Woznicki et al. teach a chocolate film coated with polydextrose, cellulosic polymer, plasticizer, lecithin, and colorant (Abstract, C2/L33-68). Given that Woznicki et al. teach a film coated chocolate identical to that presently claimed, it is clear that it would intrinsically be heat shape stable and heat resistant.

Bon Appétit and Woznicki et al. are combinable because they are concerned with the same field of endeavor, namely, confectionery products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the film-coated chocolate, as taught by Woznicki et al. sprinkled on top of the fudge of Bon Appétit because doing so would amount to nothing more than the use of a known chocolate confectionery for it use in a known environment to accomplish entirely expected results. Further, by doing so the shape of the chocolate would remain intact and more colorful fudge would be produced.

Regarding claim 12, modified Bon Appétit disclose all of the claim limitations as set forth above but the reference does not explicitly disclose that the food product has a uniform texture. Given that Bon Appétit discloses stirring the mixture vigorously (p.1/Preparation, paragraph 2) if necessarily follows that the fudge would have a uniform texture.

Regarding claim 14, modified Bon Appétit discloses all of the claim limitations as set forth above. Woznicki et al. disclose that the film coating comprises lecithin (C2/L49). However, there is no disclosure that the chocolate pieces are less than 15 millimeters in width. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the thickness of the chocolate product since such a modification would have involved a mere change in the size. Change in size is not patently distinct over the prior art absent persuasive evidence that the particular configuration of the claim invention is significant. See *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04[R-1].

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wirtz (GB 139,256) teaches a sweetmeat coated with a solution of gum arabic, coloring, and flavoring. Wirtz does not disclose a plasticizer or additional ingredients including Polysorbate 80, lecithin, stearic acid, corn starch, talc, and mixture thereof.
- Le Francois (WO (93/19615) teaches a chocolate coated biscuit or pastry that is further coated with a film. Le Francois does not teach a confectionery product with a film coating.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Gwartney whose telephone number is (571) 270-3874. The examiner can normally be reached on Monday - Thursday;7:30AM - 5:00PM EST, working alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. G./
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794